

REMARKS

After entry of the present Amendment, claims 17-19 and 23-27 are pending in the Application. Claims 17, 19, 25 and 26 were amended to correct minor typographical errors and claim dependencies. Claim 27 was added. Support for claim 27 is found in the specification at least at Reference Examples 1-4 and Example 85. No new matter is introduced by the amendments.

At the outset, Applicants seek clarification from the Examiner regarding the status of claim 26. The outstanding Office Action indicates that claim 26 was “rejoined” to the case. Claim 26 corresponds substantially to original claims 15 and 16, which were included in the originally elected group. However, in the Office Action mailed February 6, 2004, the Office Action Summary indicates that claim 26 was withdrawn. Page 2 of that Office Action states that “previously added claim 25 was not in the elected group.” Because of the Examiner’s indication that claim 26 was withdrawn, however, Applicants believe that the indication that claim 25 was not in the elected group is a typographic error, intended instead to refer to claim 26. In any event, Applicants submit that claim 26 was not properly withdrawn, as it *was* included in the originally elected group. Therefore, as the rejection of claim 26 is a first rejection on the merits, Applicants respectfully request withdrawal of the finality of the rejection.

Applicants thank the Examiner for indicating that claims 17-19 and 23-25 are in condition for allowance.

Claim 26 stands rejected. Applicants respectfully traverse the rejection, as discussed below.

Objection to the Abstract

The Office Action states that the Abstract submitted in the previous Response was “the same abstract.” However, Applicants respectfully direct the Examiner’s attention to the fact that the Abstract submitted in the previous Response deleted the reference to the specific exemplary compound that was originally included in the Abstract. It was this exemplary compound that the Examiner previously asserted was not in the elected group. Therefore, Applicants respectfully submit that the Abstract submitted in the previous Response is drawn to the elected group and request withdrawal of the objection to the Abstract.

Rejection of claim 26 under 35 U.S.C. §112, first paragraph

In the Office Action, claim 26 is rejected under 35 U.S.C. §112, first paragraph, as not enabled by the specification. Applicants respectfully traverse the rejection.

The Office Action states that the specification does not provide enablement for all diseases “treatable by mult[i]drug resistance or inhibiting transport protein.”

Applicants respectfully assert that claim 26 is fully enabled, as evidenced by the allowance of claims 17 and 18 in the parent case, issued as U.S. Patent 6,376,514. Issued patents are presumed to be valid. 35 U.S.C. § 282.

Moreover, Applicants respectfully submit that claim 26 is not directed to treatment of any specific disease *per se*. Claim 26 is directed to inhibiting transport protein activity, and is therefore, broadly directed to a common underlying mechanism of multidrug resistance. Applicants have demonstrated abrogation of multidrug resistance in the present specification. Thus, Applicants respectfully assert that it would not constitute undue experimentation for the skilled artisan to either: a) determine what diseases are associated with this mechanism; or b) determine an effective amount of the composition of claim 25 to inhibit transport protein activity, particularly in light of Applicants’ disclosure.

New claim 27 is more particularly drawn to inhibiting transport protein activity comprising contacting cells with the composition of claim 25. Applicants respectfully assert that because claim 26 is enabled (as argued above), *a fortiori*, claim 27 is also enabled, particularly in light of the teaching of the Examples 1-4 and 85. Allowance of claim 27 is respectfully requested.

Accordingly, Applicants respectfully assert that amended claim 26 and new claim 27 are fully enabled by the present specification and earnestly solicit notification to that effect.

Rejection of claim 26 under 35 U.S.C. §112, second paragraph

In the Office Action, claim 26 is rejected as indefinite. The rejection is respectfully traversed.

The Office Action states that claim 26 is a reach through claim that reads on diseases that are still to be discovered that are treatable by the recited mechanisms.

As argued above, claim 26 is not directed to treatment of any specific disease *per se*. Applicants respectfully assert that mechanism claims are not *per se* unpatentable for indefiniteness. As noted, parent U.S. Patent 6,376,514, which contains identical claim language, is presumed definite. Applicants also respectfully direct the Examiner’s attention to, e.g., U.S. Patent 6,815,458, U.S. Patent 6,815,465, U.S. Patent 6,803,362 and U.S. Patent

6,803,455. These are but a small sampling of patents including claims to underlying disease mechanisms, which are also presumed valid for definiteness.


The Examiner is reminded that breadth of a claim is not equated with indefiniteness. "If the scope and subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. §112, second paragraph." MPEP 2173.04.

In light of the above, Applicants respectfully assert that the Office Action does not carry the Office's burden of demonstrating why claim 26 does not circumscribe the claimed subject matter with a reasonable degree of clarity and particularity. MPEP 2173.02. Withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing, reconsideration and allowance of claims 17-19 and 23-26, as well as consideration and allowance of claim 27, is respectfully requested. The Examiner is strongly encouraged to contact the undersigned by telephone at the Examiner's convenience should any issues remain with respect to the Application.

Respectfully submitted,


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